

REMARKS

By the foregoing Amendment, Claims 1 and 25 are amended and Claims 18-24 are cancelled. Entry of the Amendment, and favorable consideration thereof, is earnestly requested. Claims 18-24 being cancelled herein, and Claims 10 and 12 having been cancelled previously, Claims 1-9, 11, 13-17 and 25 are currently pending.

Claims 1 and 25, the only independent claims, stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fletcher et al. (U.S. Patent No. 6,022,353) in view of Miller et al. (U.S. Patent No. 5,306,285) and Fieni (U.S. Patent No. 5,280,676). Applicant respectfully asks the Examiner to reconsider this rejection in view of the above Amendments and the below Remarks.

Initially, it should be noted that it is the Examiner's burden to establish prima facie obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955 (Fed. Cir. 1993). Obviousness requires a suggestion of all the elements in a claim (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342, 68 USPQ2d 1940 (Fed. Cir. 2003)) and "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385 (2007).

It should also be noted that Claims 1 and 25 have been amended to require, inter alia, that "the step of finite length is configured so that said first and second sections of said elongated member extend substantially parallel to each other and so that said cutting edge extends in the plane of said second section," which amendment is clearly supported, for example, by Fig. 4.

As has already been recognized by the Examiner, neither Fletcher et al. nor Miller et al. discloses, teaches or suggests a stepped configuration, which is why the Examiner has cited Fieni. Thus, clearly neither Fletcher et al. nor Miller et al. can disclose a stepped configuration having the precise features added by the above amendment. Applicant respectfully submits that Fieni also does not disclose, teach or suggest these features.

It is respectfully submitted that Fieni is not directed to a tool for making workpiece cuts in combination with an apparatus having a power driven output shaft that oscillates about an axis. By contrast the tool according to Fieni is hand-driven only. In addition, the tool is driven in forward direction while the tool according to the invention is oscillated substantially in the direction of its straight cutting edge.

Moreover, Fieni does not disclose or suggest a step that is configured so that the cutting edge extends in the plane of the second section. If 124 in Fig. 7 can be interpreted as a cutting edge, then the cutting edge extends in the plane of the first section from which the step extends.

Moreover, Applicant respectfully submits that it would not have been obvious to one of ordinary skill in the art to have modified Fieni to have arrived at the claimed invention. It should be noted that Fieni is directed to a totally different purpose than is the present invention, namely to facilitate removal of nails and shingles from a roof. These need to be drawn out from the wood but shall never be cut. So any effect arising from a step used in the tool of Fieni has a completely different effect than a step according to the invention. The step according to Fieni is used to facilitate the drawing of nails and shingles out of the wood. The step according to the invention is used to allow a better cutting operation, in particular directly along a plane surface, and to allow cutting under geometrically very narrow conditions. So given this completely different purpose of the step, a person skilled in the art would never contemplate to include a step known from Fieni in the tool known from Fletcher et al. or Miller et al. in the precise manner claimed, absent using the present application as a roadmap.

For the foregoing reasons, Applicant respectfully submits that all pending claims, namely Claims 1-9, 11, 13-17 and 25, are patentable over the references of record, and earnestly solicits allowance of the same.

Respectfully submitted,

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